



In The United States Patent and Trademark Office

Application Number: 10/092,578
Applicants: Tsung Ming Ou
Filing Date: 03/08/2002
Title: Construction Liner for American Football

Examiner: Steven B. Wong
Group Art Unit: 2823

Date: January 14, 2003

2623
#6
K. Cobb
1/29/03

RESPONSE

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

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In response to the Office Action mailed October 15, 2002, the applicant respectfully submits as follows.

Response to Rejection of Claims 1 to 8 under 35USC103

1. The Examiner rejected claims 1 and 3 over Kralik (U.S. 4,660,831) and rejected claims 1-8 over Kralik in view of Ou (U.S. 5,759,123).

2. Regarding claims 1 and 3, the Examiner appears to reason that since Kralik discloses an American football construction including a ball cover (14) having four elliptical cover pieces sewn edge to edge together, an inflatable bladder (12) and a **construction liner comprising a fabric lining (24) and a sheet material (26) laminated together**. It would have been obvious to one of ordinary skill in the art to replace the ethylene vinyl acetate sheet of Kralik with a rubber sheet in order to take advantage of rubber's well known physical characteristics.

3. However, Kralik fails to suggest the invention of claims 1 and 3, including the distinctive structural features that the construction liner for the American football as claimed in the claims 1 and 3 of the instant invention **is produced by compressing and vulcanizing a rubber piece of predetermined thickness and at least a fabric lining until the fabric lining is integrally united with the rubber piece to form the construction liner** which has a size and shape at least equal to the outer cover skin.

4. In other words, the construction liner as claimed in claims 1 and 3 of the instant invention is an integral piece that it can't find two layers laminated together. In order to better shown how the fiber lining and rubber piece integrally united to form an integral piece by means of compressing and vulcanizing. Accordingly, the applicant respectfully submits that there is no lamination of layers and there are no fabric lining (24) and sheet material (26) overlappedly laminated structure, as shown in Fig. 7 of Kralik, in the instant invention. As shown in Fig. 3(D) of the instant invention, the construction liner (24a) is an integral single piece with only one layer.

5. In the present case, Kralik has no such suggestion. Kralik and the instant invention perform very different types of construction liner, wherein Kralik merely suggests laminating a fabric layer with a sheet material to form a construction liner while the instant invention discloses a construction liner which has an integral single piece structure. Accordingly, applicants believe that the rejection of claims 1 and 3 is improper and should be withdrawn.

6. Regarding claims 1 to 8, the Examiner also appears to reason that since Ou reveals an American football including a panel formed from rubber and fabric lining, it would have been obvious to one of ordinary skill in the art to replace the ethylene vinyl acetate sheet of Kralik with a rubber sheet in order to take advantage of rubber's well known physical characteristics.

7. The applicant respectfully submits that the cited art, US 5,759,123, is a patent invented and owned by the inventor of the instant invention, Mr. Tsung Ming Ou. The '123 patent does not suggest the use of a kind of construction liner which is an integral single piece produced by **compressing and vulcanizing a rubber piece of predetermined thickness and at least a fabric lining until the fabric lining is integrally united with the rubber piece to form the construction liner** which has a size and shape at least equal to the outer cover skin so as to overlappedly attached on an inside of the cover skin to form the cover piece of the American football. However, the '123 patent does illustrate that Mr. Ou is the first inventor who utilizes the technology of vulcanizing process to integrally unite rubber with fabric to form an integral layer of material. In '123' patent, the fabric and the rubber sheets are compressed and vulcanized to form an integral piece of rubber made ball covers which are directly sewn

edge to edge to produce the sewing rubber American football so as to eliminate the need of using construction liner to support the cover skin as shown in Kralik.

8. Kralik, on the other hand, describes a different kind of construction liner which comprises at least a fabric layer (24) laminated with another sheet material to form a laminated structure with multiple layers.

9. This is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In the present case, there is no such suggestion. In any case, even combining Kralik and Ou would not provide the invention as claimed -- a clear indicia of nonobviousness.

10. Applicant believes that neither Kralik nor the applicant's another '123 patent, separately or in combination, suggest or make any mention whatsoever of a construction liner produced by compressing and vulcanizing a rubber piece of predetermined thickness and at least a fabric lining until the fabric lining is integrally united with the rubber piece to form the construction liner which has a size and shape at least equal to the outer cover skin so as to overlappedly attached on an inside of the cover skin to form the cover piece of the American football as recited in claim 1.

11. Indeed, the only mention of such reinforced integral construction liner is in applicants own specification and claims. Accordingly, it appears that the Examiner has

fallen victim to the insidious effect of a hindsight analysis syndrome where that which only the inventor taught is used against the teacher in *W.L. Gore and Associates v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983) cert. denied, 469 U.S. 851 (1984).

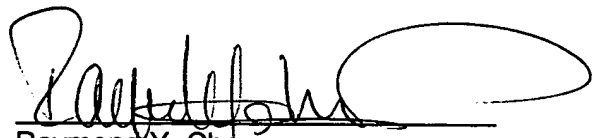
12. Accordingly, the applicant believes that the rejection of claims 1 to 8 under 35 U.S.C. 103 is improper that even though the Examiner thinks the applicant's '123 patent and the instant invention is obvious, the Examiner may reject the claim as obviousness-type double patenting. Applicant believes that for all of the foregoing reasons, the claims 1 to 8 are in condition for allowance and such action is respectfully requested.

The Cited but Non-Applied References

13. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

14. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 1 to 8 at an early date is solicited.

Respectfully submitted,

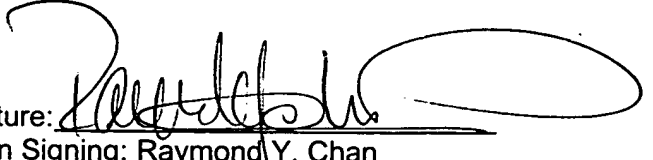


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Date: January 15, 2003

Signature: 
Person Signing: Raymond Y. Chan